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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christensen et al.

Serial No.: 09/658,607

Title: Probing Algorithm for Foundation
Fieldbus Protocol

Filed: September 8, 2000

Group Art Unit: 2182

Examiner: Patel, Niketa I

Atty. Docket Number: 06005/36805

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RESPONSE TO OFFICE ACTION DATED MARCH 16, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Technology Center 2100

Dear Sir:

In response to the election of species requirement raised in the Office action dated March 16, 2004, applicants hereby elect, *with traverse*, the species corresponding to identified species group I for further prosecution in this application. Applicants respectfully submit that claims 1-36 read on the elected species, because none of the claims recite characteristics that are mutually exclusive of the characteristics that define identified species group I.

Applicants respectfully submit that the Examiner has not made a *prima facie* showing that each of the species groups identified in the Office action relate to a patentably distinct species. According to MPEP 803, “Examiners must provide reasons and/or examples to support conclusions, ... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02. ... Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP 806.04(a) - 806.04(i) and 808.01(a).” Contrary to the requirements above, the Examiner has not provided reasoning or examples for the conclusion

that each of the identified species groups is in fact a different species or shown that there would be a serious burden on the Examiner without the species election. Further, the Examiner has not satisfied the necessary criteria for an election of species, as required by MPEP 803, because the identified species groups have been improperly identified according to the claims and because the identified species groups are not mutually exclusive.

Contrary to the requirements of MPEP 803, the Examiner has not provided reasons or examples for concluding that patentably distinct species exist within the application. In particular, the Examiner has not demonstrated or explained how each of the species groups I-IV requires a separate classification, separate status in the art, or a different field of search, as required by MPEP 803. Instead, the Examiner merely asserts that the application contains claims directed to patentably distinct species without definitively demonstrating that these patentably distinct species exist. A mere assertion that the claims are directed to patentably distinct species does not, in and of itself, establish a *prima facie* case that such species exist.

Furthermore, the Examiner has merely defined the identified species according to claim limitations, and not in accordance with any other identifiable criteria. However, according to MPEP 806.04(e), “[c]laims are definitions of inventions. *Claims are never species.*” (Emphasis in original). Thus, species groups are not defined according to the claims. Nonetheless, the Examiner has defined each species by paraphrasing claim limitations of different claims without providing any other criteria mandating the species election. Because the Examiner has merely defined the species according to the claims, the Examiner has not met the criteria of MPEP 806.04(e) and MPEP 803.

Further contrary to the criteria for species election, the Examiner has not defined the identified species groups according to mutually exclusive characteristics. In fact, MPEP 806.04(f) requires that “[c]laims to be restricted to different species must be mutually exclusive. ... [C]laims to be restricted to different species must recite the mutually exclusive characteristics of such species.” In this case, however, the Examiner has not demonstrated, or even stated, that any of the claims to be restricted to the identified species groups recite mutually exclusive characteristics.

In fact, claims that recite characteristics defining the identified species groups are, by definition, not mutually exclusive. A dependent claim cannot be restricted to a species group different than the claim from it depends, because the dependent claim includes all the

characteristics of the claim from which it depends. Those characteristics are therefore not mutually exclusive to either the dependent claim or the claim from which it depends.

Nonetheless, the Examiner has defined the identified species groups according to characteristics recited in claims that depend from, and thus include all the characteristics of, claims that recite characteristics used to define other ones of the identified species groups. As an example, claim 2, which recites characteristics used to define identified species group II, depends from claim 1, which recites characteristics used to define identified species group I. As noted above, MPEP 806.04(f) precludes the Examiner from defining the species as identified species groups I and II have been defined. Likewise, claim 8 recites characteristics used to define identified species group III, and ultimately depends from claim 1. As such, identified species group III cannot include characteristics that are mutually exclusive of identified species group I, because claim 8 includes by definition the characteristics common to both identified species groups I and III. Still further, identified species group IV is defined by characteristics recited in claim 9 which depends from claim 1, and includes all of the characteristics of claim 1, including the characteristics used to define identified species group I. Therefore, identified species groups I, II, III and IV are not defined by mutually exclusive characteristics.

Moreover, the figures of the application further demonstrate that many of the identified species groups are not defined by mutually exclusive characteristics. For example, Figure 5 shows that a probing algorithm 56 may probe addresses found in the first, second and third address lists to detect the presence of a device (identified species group II), and that the probing algorithm may also probe each address in the third address list 54 more frequently than each address in the first address list 50 and each address in the second address list 52 (identified species group I). (See application, p. 6, ln. 16-19; p.16, ln. 27 to p. 17, ln. 17; and p. 18, ln. 16-20). Figure 5 further shows that the probing algorithm 56 may select addresses from the first, second and third address lists in a sequential order with rollover (identified species group III). (See application, p. 17, ln. 9-15). The frequency at which each of the addresses in the third address list is probed may be sufficient to prevent the devices from reaching a fault condition (identified species group IV). (See application, p. 18, ln. 25 to p. 19, ln. 2). As a result, the above-mentioned characteristics are not mutually exclusive. The Examiner has therefore improperly identified each of these features as relating to a separate species (i.e., identified species groups I-IV).

Because the Examiner has not alleged, much less demonstrated, mutually exclusive characteristics for each of the identified species groups, and because the claims and figures demonstrate that the identified species groups actually lack mutually exclusive characteristics, the Examiner has not properly restricted the claims based on species criteria, as required by MPEP 806.04(f) and MPEP 803.

For these reasons, applicants respectfully submit that the requirements for election of species are not met, and that the election should be withdrawn. As a result, applicants respectfully request that each of claims 1-36 presently pending in this application be examined. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

By:


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